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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DEAN F. JERDING, ROBERT O. BANKER,
ARTURO A. RODRIGUEZ, VALERIE GREW GUTKNECHT
and BINDU CRANDALL

Appeal 2008-1612
Application 09/692,995
Technology Center 2600

Decided: August 18, 2008

Before JOSEPH F. RUGGIERO, JOHN A. JEFFERY,
and KEVIN F. TURNER, *Administrative Patent Judges*.

TURNER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 from the Final Rejection of claims 80, 82, 83, 85, 86, and 90-101, which are all of the claims pending in this application. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

Appellants' invention relates to a "system for providing media to a user via an interactive media services client device coupled to a programmable media services server device", which allows users to easily and conveniently access portions of the media that they desire. (Spec. 2:1-12).

Claim 80 is illustrative of the invention and reads as follows:

80. A method implemented by a television set-top terminal (STT) coupled via a bidirectional communication network to a server located remotely from the STT in a cable television headend, said method comprising steps of:

receiving via a tuner in the STT a video presentation provided by the server located in the cable television headend, wherein the video presentation is a video-on-demand presentation;

outputting by the STT at least a portion of the video presentation as a video-on-demand television signal;

receiving a first user input associated with bookmarking a visual scene contained in the video presentation, including receiving a character sequence to be assigned to the visual scene while the video presentation is being presented to the user;

storing information related to the visual scene in a memory of the STT responsive to receiving the first user input, including storing only in the memory of the STT information related to the visual scene in response to receiving the first user input, including storing only in the memory of the STT data corresponding to the character sequence in response to receiving the user input configured to assign the character sequence to the visual scene;

outputting by the STT at least another portion of the video presentation as a video-on-demand television signal;

receiving a second user input configured to request from the headend the visual scene in the video presentation after the STT has output the at least another portion of the video presentation;

responsive to receiving the second user input, requesting by the STT that the headend send the video presentation beginning from the requested visual scene;

receiving by the STT from the headend the video presentation beginning from the requested visual scene; and

outputting by the STT a video-on-demand television signal comprising a portion of the video presentation starting from a location corresponding to the visual scene responsive to the second user input, wherein the location corresponding to the visual scene is identified by the STT using the information related to the visual scene, including using information related to the visual scene stored only in the STT.

The Examiner relies on the following prior art references to show unpatentability:

Dunn	US 5,861,906	Jan. 19, 1999
Wang	US 6,501,902 B1	Dec. 31, 2002 (filed Jan. 27, 1999)
White	US 6,628,302 B2	Sep. 30, 2003 (filed Nov. 30, 1998)
Lewis	WO 00/04726 A2	Jan. 27, 2000

Claims 80, 82, 83, 85, 86, 90-92, and 96-100 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over White and Lewis.

Claim 93 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over White, Lewis, and Dunn.

Claims 94, 95, and 101 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over White, Lewis, and Wang.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Briefs and Answer for the respective details. Only those arguments actually made by Appellants have been considered in this decision. Arguments which Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived [see 37 C.F.R. § 41.37(c)(1)(vii)].

ISSUES

- (i) Under 35 U.S.C. § 103(a), with respect to appealed claims 80, 82, 83, 85, 86, 90-92, and 96-100, do White and Lewis teach or suggest all of the elements of those claims to render those claims unpatentable?
- (ii) Under 35 U.S.C. § 103(a), with respect to appealed claim 93, do White, Lewis, and Dunn teach or suggest all of the elements of that claim to render it unpatentable?
- (iii) Under 35 U.S.C. § 103(a), with respect to appealed claims 94, 95, and 101, do White, Lewis, and Wang teach or suggest all of the elements of those claims to render those claims unpatentable?

FINDINGS OF FACT

1. The Specification details that a television set-top terminal is in communication with a headend through a network and a television. The system also has a receiver for receiving instructions from a user's remote control and a tuner that allows for displaying media received from the headend on the television. Applications stored in memory are executed by a

processor of the set-top terminal including a media-on-demand application. (Spec. 7:13 – 10:16; Fig. 3, elements 11, 16, 18, 41, 45, 46, 52, 63, and 80).

2. White discloses an interactive video programming system that uses a head-end to provide video-on-demand services through a distribution network to client terminals in users' homes. The system allows the user to request video-on-demand programming, as well as pause delivery of that programming for certain periods of time. (Abstract; col. 4, l. 65 – col. 5, l. 26).

3. Lewis discloses a digital video apparatus which permits a user to "bookmark" portions of a video presentation. When a user specifies a bookmark point, that position is saved in memory and the program continues to be presented. The system "allows the user to avoid the inconvenience of having to manipulate various transport keys in order to locate and start playback from a selected location within a video title or chapter." (Abstract; 2: 11-14; 7: 12-29).

PRINCIPLES OF LAW

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). "[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability." *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). Furthermore,

“. . .there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness’ . . . [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007)(quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

Where a combination is an adaptation of an old idea or invention using newer technology that is commonly available and understood in the art, one of ordinary skill in the art would have found it obvious to make the combination in order to gain the commonly understood benefits of such adaptation. *Leapfrog Enterprises, Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007).

ANALYSIS

Appellants argue that White fails to teach or suggest “receiving a second user input configured to request from the headend the visual scene in the video presentation after the STT has output the at least another portion of the video presentation,” as recited in claim 80. (App. Br. 9). Similar arguments are made on the same bases with respect to independent claim 96. (App. Br. 14). Appellants assert that “[o]nce the stop or pause functions of *White* are activated, the system in *White* does not appear to output any portion of [the] content from the given video presentation.” (App. Br. 9). Appellants also argue that White also fails to teach or suggest that the video presentation is sent beginning from the requested visual scene. (App. Br. 10). We note, however, that Appellants are arguing with respect to what

White alone teaches, rather than what White and Lewis teach in combination. As Appellants are surely aware, one cannot show nonobviousness by attacking references individually where the rejection is based on a combination of the references. *In re Keller*, 642 F.2d 413 (CCPA 1981).

In a similar fashion, Appellants argue that Lewis only describes the functions of a DVD player, and not a set-top terminal and its interaction with a headend in a video-on-demand system. (App. Br. 11). Again, since independent claims 80 and 96 are rejected over White and Lewis in combination, the fact that Lewis is not directed to a video-on-demand system is not dispositive.

Appellants argue that “it would not have been obvious to combine White and Lewis, and the combination is unreasonable because the [sic] there is considerable complexity involved in bookmarking content from the headend of a VOD network that is not addressed in either of the prior art references.” (App. Br. 12). However, we agree with the Examiner, in that White and Lewis are analogous art and adequate motivation to combine the references has been proffered (i.e. allowing the user to avoid the inconvenience of having to manipulate various keys in order to locate and start playback from a selected location). (Ans. 17).

Appellants also argue that bookmarking at a local client is considerably more simple and different than bookmarking content over a video-on-demand network. (App. Br. 12). However, we agree with the Examiner that Appellants have supplied no evidence supporting their assertion that such complexity would dissuade one of ordinary skill in the art from combining White and Lewis. (Ans. 18). Additionally, we find the

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adaptation of bookmarking of scenes to the technology of video-on-demand to be commonly available and understood in the art, and that one of ordinary skill in the art would have found it obvious to make the combination in order to gain the benefits disclosed in Lewis. (FF 3). As such, we find no error in the Examiner's rejection of independent claims 80 and 96. This finding flows as well to claims 82, 83, 85, 86, and 90-92, since those claims were argued to be allowable by virtue of their dependence on independent claims 80 and 96.

With respect to the rejection of claims 93-95 and 101, over White, Lewis and either Dunn or Wang, we note that those claims all depend from either independent claim 80 or independent claim 96. Appellants argue that claims 93-95 and 101 are allowable based their dependence on the independent claims and because neither Dunn nor Wang remedies the deficiencies of White and Lewis. (App. Br. 15-16; Reply Br. 9-10). However, as we find no such deficiencies in the combination of White and Lewis as applied against independent claims 80 and 96, Appellants have provided no other rationale for overturning the rejections of claims 93-95 and 101. As such, we affirm the rejection of claims 93-95 and 101.

CONCLUSION

In summary, we have affirmed the Examiner's 35 U.S.C. § 103(a) rejections of all of the claims on appeal. Therefore, the decision of the Examiner rejecting claims 80, 82, 83, 85, 86, and 90-101 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

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AFFIRMED

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